

REMARKS

Claims 29-54 are pending in the application.

Claims 29-50 are withdrawn from consideration.

Claims 51-54 are rejected.

Claim 52 is canceled.

Claim 51 is amended.

Reconsideration and allowance of claims 51, 53 and 54 is respectfully requested in view of the following:

Responses to Rejections to Claims – 35 U.S.C. §102

Claims 51 and 53-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito et al (U.S. Patent No. 6,191,941) (Ito). This rejection is not applicable to the amended claims.

Claim 51 includes: the first subassembly and the second subassembly coupled together by a hinge about which the first and second subassemblies rotate and engage their respectively inverse patterns when mated to form the battery assembly wherein the first battery subassembly exhibits at least one of a first cell chemistry and a first power capacity and the second battery subassembly exhibits at least one of the first cell chemistry, the first power capacity, a second cell chemistry and a second power capacity.

The USPTO provides MPEP §2131 that: "To anticipate a claim, the reference must teach every element of the claim."

Therefore, to support these rejections with respect to claims 51, 53 and 54, Ito must contain all of the above-claimed elements. However, this patent does not disclose the first subassembly and the second subassembly coupled together by a hinge about which the first and second subassemblies rotate and engage their respectively inverse patterns when mated to form the battery assembly wherein the first battery subassembly exhibits at least one of a first cell chemistry and a first power capacity and the second battery subassembly exhibits at least one of the first cell chemistry, the first power capacity, a second cell chemistry and a second power capacity.

As a result, the previous rejections based on 35 U.S.C. 102(b) cannot be supported by Ito as applied to claims 51, 53 and 54.

Responses to Rejections to Claims – 35 U.S.C. §103

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ito as applied to claims 51, 53 and 54 above, and in further view of Perkins This rejection is not applicable to the amended claims.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach the first subassembly and the second subassembly coupled together by a hinge about which the first and second subassemblies rotate and engage their respectively inverse patterns when mated to form the battery assembly wherein the first battery subassembly exhibits at least one of a first cell chemistry and a first power capacity and the second battery subassembly exhibits at least one of the first cell chemistry, the first power capacity and a second power capacity a second cell chemistry.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Recently, the Supreme Court ruled that the "teaching, suggestion, or motivation (TSM) test" for determining obviousness still applies, but should be used in a more "expansive and flexible"

manner. *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. __, 11 (2007). The Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 14-15, emphasis added.

Thus, in the present case it is clear that the USPTO's combination arises solely from hindsight based on the present disclosure without any reason why a person of ordinary skill in the art would combine the references as required by the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

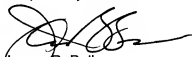
Therefore, independent claim 51 and respective dependent claims 53 and 54 are submitted to be allowable.

In view of all of the above, the allowance of claims 51, 53 and 54 is respectfully requested.

The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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